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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,708	04/30/2001	James R.H. Challenger	Y0R9-2001-0281US1 (8728-5)	2686
46069	7590	09/20/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,708

Applicant(s)

CHALLENGER ET AL.

Examiner

CESAR B. PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-21 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the RCE filed on 7/7/2005.

This action is made Non-Final.

2. In the amendment, claims 1-12, 22-23, and 28-31 have been canceled. Claims 16-21, and 24 are pending in the case. Claim 16 is an independent claim.
3. The rejections of claims 16-20, and 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, and further in view of Truong (Pat.# 6,151,609, 11/21/2000) have been withdrawn as necessitated by the amendment.
4. The rejection of claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, and further in view of Truong, and further in view of Pagemill has been withdrawn as necessitated by the amendment.
5. The rejection of claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, and further in view of Truong, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000) has been withdrawn as necessitated by the amendment.

Drawings

6. The drawings filed on 4/30/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Takashi et al, hereinafter Takashi (US Pub. # 2002/0059162, 5/16/2002, filed on 2/8/1999), and further in view of Lemay et al, "Laura Lemay's Web Workshop Creating Commercial Web Pages", hereinafter Lemay, Sams.net, 1996, pp.110-115), and further in view of Truong (Pat.# 6,151,609, 11/21/2000), and further in view of Levy et al, hereinafter Levy (USPub 2003/00112548 A1, 1/16/2003, provisional application filed on 12/21/2000).

Regarding independent claim 16, Troyansky teaches inserting or storing a digital watermark into digital content --*determining a content creation preference*--by replacing or converting parts of digital files, such as HTML files--*electronically encoded HTML document*--with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts,

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which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), into an image.

Furthermore, Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining, at a server, the content in text format, automatically by the server.*

However, Truong teaches an Internet server receiving an HTML file selection. In response, the Internet server communicates the HTML file in textual format to a requesting client (col.8, lines 38-53). Takashi teaches clients accessing or requesting HTML web pages information from a server (0020, 0005, 0024, 2nd parag.). Levy teaches the addition, and dynamic linking of a watermarked image in a web page at the time of rendering the web page (0094)—*generating an HTML containing a reference to the stored content in the image format for retrieval and inline dynamic assembly by the client.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Takashi, Lemay, and Truong, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 17, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts into an image.

Regarding claim 18, which depends on claim 13, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as image files with hidden images--*watermarks* (0003). Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining the content in text format*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have retrieved the image file, because Troyansky teaches enforcing digital rights of image documents, by inserting watermarked information into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 19, which depends on claim 16, Troyansky teaches compressing a watermark using lossy compression algorithms--*watermarking preference* (0004, lines 6-9).

Regarding claim 20, which depends on claim 19, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, further in view of Truong, further in view of Levy, and further in view of Pagemill.

Regarding claim 21, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display*

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coordinates to external document identifiers in order to enable user navigation. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL—*external document identifier*-- of the respective area (page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Takashi, Lemay, Truong, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Takashi, in view of Lemay, and further in view of Truong, , further in view of Levy, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

Regarding claim 24, which depends on claim 19, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files such as image (0003). Troyansky fails to explicitly disclose: *receiving a client system request for verification of the watermarked content.* However, Minematsu teaches a user terminal transmitting first transmission of watermarked information to a detection center, where the information is authenticated. The information is then transmitted to the user terminal, where the authentication result is displayed (col.3, lines 61-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky,

Lemay, and Minematsu, because Minematsu teaches providing a tamper resistant watermarked image for encrypting information (col. 3, lines 57-67). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Response to Arguments

11. Applicant's arguments with respect to claim 5/5/2005 have been considered but are moot in view of the new ground(s) of rejection. The Applicants indicate that the Troyansky, and the prior art do not teach suggest generating an HTML document containing a reference the stored content in the image format for retrieval and inline dynamic assembly by the client (pages 7-). The Applicants are directed towards the rejection of these claims in light of the newly applied rejection above.

Claims 17-21 are rejected at least based on the rationale stated in the newly included rejections above.

Conclusion

- I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Levy et al. (Pat. # 2003/0056103 A1), and Kirovsky et al. (Pat. # 2002/0191809 A1).
- II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for **all** Formal communications intended for entry)

9/16/05


CESAR PAULA
PRIMARY EXAMINER